

**REMARKS:**

Claims 1-37 remain in the application for consideration.

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("Cupps") in view of U.S. Patent No. 4,971,406 to Hanson ("Hanson") and U.S. Patent No. 5,895,454 to Harrington ("Harrington"), and further in view of U.S. Patent No. 6,657,702 to Chui et al. ("Chui"). Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over Cupps in view of Hanson and Harrington, and further in view of U.S. Patent No. 4,797,818 to Cotter ("Cotter").

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the above amendments and following remarks.

**REJECTIONS UNDER 35 U.S.C. § 112:**

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action alleges that maximum delivery time *and* the indication of importance is considered new based on the usage of the word "or" on page 9, line 2 of the Specification. This allegation is respectfully traversed.

MPEP 2163 provides guidelines for determining whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. MPEP 2163(III)(A) provides that the Examiner bears the initial burden of establishing that claims fail to comply with the written description requirement:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a

reasonable basis to challenge the adequacy of the written description. **The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.** *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

(Emphasis added). Thus, failure to comply with the written description requirement must first be established by the Examiner, and the showing must be made by a preponderance of the evidence. MPEP 2163(III)(A) then explains that a proper showing must include express findings of fact that establish reasons why one skilled in the art would not have recognized that the inventor possessed the claimed invention:

In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing **reasons why a person skilled in the art at the time the application was filed would not have recognized** that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

(Emphasis added). It should also be noted that the standard for compliance with the written description requirement involves the person of ordinary skill in the art, and what such a person would understand based on the written description:

The fundamental factual inquiry is whether the specification conveys with reasonable clarity **to those skilled in the art** that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

MPEP 2163 (emphasis added). As pointed out in MPEP 2163, **"there is no *in haec verba* requirement."** (emphasis added).

Thus, the Examiner bears the initial burden of establishing a *prima facie* case of failure to comply with the written description requirement, and in order to do so the Examiner must establish, by a preponderance of the evidence, reasons why one of ordinary skill in the art would not have recognized from the written description that the

inventor was in possession of the claimed invention at the time the application was filed. It is respectfully submitted that this burden has not been met in the present case.

Applicant respectfully directs the Examiner's attention to page 8, lines 23-28 of the Specification, which states:

Customer preference information for a customer 12 may include any information relating to the personal preferences of the customer 12. For example, in one embodiment, the customer preference information for customer 12 may include maximum and/or minimum price preferences, maximum delivery time preferences, and restaurant rating preferences of the customer 12. A particular preference of a customer 12 may be represented in any appropriate manner.

Thus, the Specification provides clear and explicit support for a combinations of types of personal preferences. Thus, there is no preponderance of evidence to establish that the present claims fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

In light of the discussion above, it is respectfully requested that the rejection of claims 1-37 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. § 103:**

Claims 1-11, 13-21, 23-34, 36, and 37:

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over Cupps in view of Hanson and Harrington, and further in view of Chui.

This rejection is respectfully traversed.

Specifically, with respect to claim 1 (as well as claims 2-12, which depend from claim 1), this claim recites a system for brokering food order transactions comprising one or more databases. Claim 1 has been amended to further recite that one or more of the databases contain "delivery information associated with each of a plurality of buyers including a maximum delivery time preference of at least one of the

*plurality of buyers and an indication of how important the delivery time is to the at least one of the plurality of buyers."*

The Office Action acknowledges that Cupps, Hanson, and Harrington each fails to disclose or suggest a database that includes such delivery time preference and importance information for buyers. However, the Office Action alleges that this limitation is taught by Chui. This allegation is respectfully traversed. The Office Action points to item 240 in Figure 2D in support of this allegation, and reasons that the selection of a mode of delivery constitutes an indication of importance of delivery time. However, it is respectfully pointed out that the indication of mode of delivery shown in Figure 2D is a step in a check-out process (See Chui, col. 10, lines 13-15). Thus, solely for the sake of argument, assuming that selection of a mode of delivery constitutes an indication of importance of delivery time (although this point is not conceded), Chui would still fail to disclose or suggest storing such information as a buyer's preference information. Thus, the proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest all of the limitations of claim 1.

Accordingly, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 1, or claims 2-12 depending from claim 1.

**Attention is also drawn to claim 2**, which depends from claim 1. Claim 2 recites "the indication of how important the delivery time is to the buyer includes at least one of an indication that delivery time is very important, an indication that delivery time is important, and an indication that delivery time is unimportant." As pointed out above, the proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest the storage of delivery time importance preferences for buyers. It follows that the proposed combination of Cupps, Hanson, Harrington, and Chui likewise fails to disclose or suggest the more specific limitations in claim 2 involving storing an indication that delivery time is very important, important, or unimportant. For at least this additional reason, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 2.

**Attention is further drawn to claim 3**, which depends from claim 1. Claim 3 recites “the maximum delivery time preference is obtained from the buyer while the buyer is registering as a new user of the system.” The proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest storing a maximum delivery time preference obtained from a buyer during registration as a new user of the system. For at least this additional reason, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 3.

With respect to independent claims 13, 23, and 24, each of these claims includes limitations similar to those discussed above in connection with claim 1. Therefore, the comments presented above in connection with claim 1 apply equally to claims 13, 23, and 24, as well as claims 14-22, 36, and 37 depending from claim 13, and claims 25-35 depending from claim 24. Thus, for at least the reasons discussed above in connection with claim 1, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 13-37.

Also, claims 14 and 25 include limitations similar to those discussed above in connection with claim 2. Therefore, the comments presented above in connection with claim 2 apply equally to claims 14 and 25. Thus, for at least the additional reason discussed above in connection with claim 2, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 14 and 25.

Also, claims 15 and 26 include limitations similar to those discussed above in connection with claim 3. Therefore, the comments presented above in connection with claim 3 apply equally to claims 15 and 26. Thus, for at least the additional reason discussed above in connection with claim 3, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 15 and 26.

For the reasons set forth herein, the Applicants submit that claims 1-37 are not rendered obvious by the proposed combination of Cupps, Hanson, Harrington, and Chui. The Applicants further submit that claims 1-37 are in condition for allowance. Therefore, the Applicants respectfully request that claims 1-37 be allowed.

Claims 12, 22, and 35:

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over Cupps in view of Hanson and Harrington, and further in view of Cotter.

Claim 12 depends from independent claim 1, claim 22 depends from independent claim 13, and claim 35 depends from independent claim 24. As discussed above, claims 1, 13, and 35 as amended herein are considered patentable over the proposed combination of Cupps, Hanson, Harrington, and Chui at least because this proposed combination fails to disclose or suggest one or more of the databases contain “delivery information associated with each of a plurality of buyers including a maximum delivery time preference of at least one of the plurality of buyers *and an indication of how important the delivery time is to the at least one of the plurality of buyers.*” Cotter likewise fails to disclose or suggest this limitation, so the combined teachings of Cupps, Hanson, Harrington, and Cotter would still fail to disclose or suggest all of the limitations of claims 1, 13, and 24. Since claims 12, 22, and 35 depend from claims 1, 13, and 24, respectively, the proposed combination of Cupps, Hanson, Harrington, and Cotter would likewise fail to disclose or suggest all the limitations of claims 12, 22, and 35 as well. Since the proposed combination of Cupps, Hanson, Harrington, and Cotter fails to disclose or suggest all of the limitations of claims 12, 22, and 35, the proposed combination cannot render obvious claims 12, 22, and 35.

For the reasons set forth herein, the Applicants submit that claims 12, 22, and 35 are not rendered obvious by Cupps in view of Hanson and Harrington, and further in view of Cotter. The Applicants further submit that Claims 12, 22, and 35 are in condition for allowance. Therefore, the Applicants respectfully request that Claims 12, 22, and 35 be allowed.

**CONCLUSION:**


In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

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